

Re. : Amendment and Response to Office Action Mailed December 31, 2007
Appl. No. : 10/789,581
Filed : February 26, 2004

II. REMARKS

The Office Action rejected Claims 1-41. By the foregoing amendments, Applicant cancelled Claims 1-27 and 30-48 without prejudice, amended Claims 28-29 and added new Claims 46-47 to further clarify, more clearly define and/or broaden the claimed invention, and expedite receiving a notice of allowance. Pursuant to 37 C.F.R. § 1.121(f), no new matter is introduced by these amendments. After these amendments, Claims 28-29 and 49-53 are now pending in the application. Applicant believes that Claims 28-29 and 49-53 are now in condition for allowance.

Please note that Applicant's remarks are presented in the order in which the issues were raised in the Office Action for the convenience and reference of the Examiner. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's discussion and understanding of the references, if any, is consistent with the Examiner's. Further, the following remarks are not intended to be an exhaustive enumeration of the distinctions between any particular reference and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and that reference.

A. Finality of the next action is precluded.

As shown below, the Office Action failed to establish a *prima facie* case of unpatentability of Claim 28 (now rewritten in independent form) at least because the cited references do not disclose, or inherently include, each feature recited in Claim 28.

Applicant respectfully submits that this failure precludes the finality of a next Office action rejecting Claim 28 because such a rejection will not have been necessitated by either a claim amendment or based on information from an information disclosure statement. *See* MPEP § 706.07(a).

B. Response to rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a)

The Office Action rejected Claims 1-11 and 14-18 under 35 U.S.C. § 102(e) over United States patent no 6,959,075 by Cutaia.

Re. : Amendment and Response to Office Action Mailed December 31, 2007
Appl. No. : 10/789,581
Filed : February 26, 2004

The Office Action rejected Claims 12-13 under 35 U.S.C. § 103(a) over the *Cutaia* patent.

The Office Action rejected Claims 19-28 under 35 U.S.C. § 103(a) over United States patent application publication no. 2002/0176546 by Dietz et al. in view of United States patent no. 6,671,353 by Goh in further view of United States patent no. 7,043,266 by Chaturvedi.

The Office Action rejected Claims 29-30 under 35 U.S.C. § 103(a) over the *Dietz* reference in view of the *Goh* patent in further view of the *Chaturvedi* patent and United States patent no. 6,665,283 by Harris et al.

The Office Action rejected Claims 31-36 under 35 U.S.C. § 103(a) over the *Dietz* reference in view of the *Goh* patent in further view of the *Chaturvedi* patent and the *Harris* patent.

The Office Action rejected Claims 37-41 under 35 U.S.C. § 103(a) over the *Dietz* reference in view of United States patent no. 5,867,793 by Davis in further view of United States patent no. 5,363,258 by Schmidt.

Applicant respectfully traverses these rejections at least because the cited references are not properly combined and the cited references, either alone or in combination, fail to disclose each claimed feature. Nevertheless, as mentioned above, to expedite receiving a notice of allowance, Applicant has cancelled Claims 1-27 and 30-48 without prejudice to pursuing such in a related application. Thus, of the previously pending Claims 1-48, Claims 28 and 29 remain.

1. The Office Action failed to provide a *prima facie* case of obviousness of Claim 28.

Claim 28 recites “receiving real-time voice data at a device of a recipient in an instant connect call; playing the real-time voice data being received at the device while buffering the real-time voice data in a buffer;” “in response to input from the recipient during the instant connect call and while continuing to buffer the real-time voice data in the buffer from the instant connect call: preventing the real-time voice data being received from being played; replaying at least a portion of the buffered voice data from the buffer during the instant connect call; and providing functions on the device related to the buffered voice data, wherein the functions enable the recipient to alter how the buffered voice data is replayed, including jumping to the real-time voice data when the recipient begins talking and jumping to the real-time voice data when the

Re. : Amendment and Response to Office Action Mailed December 31, 2007
Appl. No. : 10/789,581
Filed : February 26, 2004

recipient requests a floor;” and “wherein buffering the voice data in a buffer further comprises removing silences between one or more senders such that silences are not buffered.” **Thus, Claim 28 recites, among other things, receiving real-time voice data at a device of a recipient in an instant connect call, playing the real-time voice data being received at the device, buffering the real-time voice data in a buffer, and that buffering the voice data in a buffer further comprises removing silences between one or more senders such that silences are not buffered.**

With respect to Claim 28, the Office Action merely asserted that paragraph [0018] of the *Dietz* reference teaches removing periods of silence: “Regarding claim 28, Dietz teaches removing period of silence (paragraph 0018).”¹ The Office Action failed to provide a *prima facie* case of obviousness of Claim 28 for several reasons.

First, the Office Action failed to provide a *prima facie* case of obviousness of Claim 28 because its analysis failed to consider each claimed feature. Claim 28 recites that “buffering the voice data in a buffer further comprises removing silences between one or more senders such that silences are not buffered.” Thus, Claim 28 recites a key claimed context (“buffering”) and a key claimed result (“silences are not buffered”). The Office Action’s analysis, however, failed to consider both this claimed context and claimed result. Thus, the Office Action failed to provide a *prima facie* case of obviousness of Claim 28.

Second, the Office Action failed to provide a *prima facie* case of obviousness of Claim 28 because the *Dietz* reference does not discuss “removing silences” as part of a buffering process and certainly does not disclose that “silences are not buffered.” In fact, the cited paragraph [0018] of the Dietz reference teaches the exact opposite: that silences are buffered, but later dropped during playback.² Thus, the *Dietz* reference teaches away from “silences are not buffered.”

Third, the Office Action failed to provide a *prima facie* case of obviousness of Claim 28 because the Office Action did not cite or articulate any teaching, suggestion, motivation or other reason why, along with the other claimed features, the claimed result “that silences are not

¹ Office Action, at 9.

² See United States patent application publication no. 2002/0176546, ¶ [0018].

Re. : Amendment and Response to Office Action Mailed December 31, 2007
Appl. No. : 10/789,581
Filed : February 26, 2004

buffered” would have been obvious in view of the *Dietz* reference, which teaches the exact opposite.

Fourth, the Office Action failed to provide a *prima facie* case of obviousness of Claim 28 because the modifications that the Office Action proposed would vitiate a key purpose of the *Dietz* system. The Office Action asserts that it would be obvious to modify the *Dietz* system to use the *Goh* patent’s user-initiated “start/stop functions.” The *Dietz* reference, however, disparages such systems that require a user to consciously act. In particular, the *Dietz* reference disparages systems that use hold buttons because a user may not be able to anticipate the need for the hold and may not realize the need for a hold until it was too late.³ As an alternative to such systems, the *Dietz* reference teaches to automatically “buffer an incoming audio signal when the handset is removed from the ear,”⁴ which accounts for situations when the user reacts to unexpected distractions.⁵ If the *Dietz* system were modified to use the *Goh* patent’s user-initiated “start/stop functions,” the *Dietz* system would no longer be able to account for situations where users reacted to unexpected distractions -- thus vitiating a the key purpose of the *Dietz* system.

Fifth, the Office Action failed to provide a *prima facie* case of obviousness of Claim 28 because the Office Action did not cite or articulate any teaching, suggestion, motivation or other reason that it would be obvious to modify the *Dietz* system to use the *Goh* patent’s user-initiated “start/stop functions” when the *Dietz* reference teaches away from such systems that require a user to consciously act.

Sixth, the Office Action failed to provide a *prima facie* case of obviousness of Claim 28 because the Office Action did not cite or articulate any teaching, suggestion, motivation or other reason why one of ordinary skill in the art would have **both** (1) added the “PTT mode” of the *Chaturvedi* patent to the *Dietz* system ; **and** (2) provided any replaying functionality with such “PTT mode.”

³ See United States patent application publication no. 2002/0176546., ¶ [0003].

⁴ See United States patent application publication no. 2002/0176546., ¶¶ [0006] to [0007].

⁵ See United States patent application publication no. 2002/0176546., ¶ [0002].

Re. : Amendment and Response to Office Action Mailed December 31, 2007
Appl. No. : 10/789,581
Filed : February 26, 2004

Thus, for at least these reasons, the Office Action failed to provide a *prima facie* case of obviousness of Claim 28. Moreover, the Office Action failed to provide a *prima facie* case of obviousness of Claim 29 (which depends from Claim 28) for at least the same reasons.

C. New Claims

New Claims 49-53 have been added to more fully define the Applicant's invention and are believed to be fully distinguished over the cited references.

CONCLUSION

Applicant submits that Claims 28-29 and 49-53 are allowable over the cited references and are in condition for allowance. Accordingly, Applicant requests that a Notice of Allowance be promptly issued.

If any further impediments to allowance of this application remain, the Examiner is cordially invited to contact the undersigned by telephone so that these remaining issues may be promptly resolved.

Re. : Amendment and Response to Office Action Mailed December 31, 2007
Appl. No. : 10/789,581
Filed : February 26, 2004

The Commissioner is authorized to charge payment of any additional fees associated with this communication, which have not otherwise been paid, to Deposit Account No. 23-3178. If any additional extension of time is required, which have not otherwise been requested, please consider this a petition therefore and charge any additional fees that may be required to Deposit Account No. 23-3178.

DATED this 27th day of May, 2008.

Respectfully submitted,

/Ryan N. Farr/ Reg. No. 52,882

Ryan N. Farr
Registration No. 52,882
Attorney of Record

Customer No. 22,913

WORKMAN NYDEGGER
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 533-9800
Facsimile: (801) 328-1707
E-mail: RFarr@wnlaw.com